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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,462	02/28/2002	Tomohiro Koyata	7217/66559	1812
530	7590	08/25/2006	EXAMINER	
LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			BAYAT, BRADLEY B	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/085,462	KOYATA ET AL.
	Examiner Bradley B. Bayat	Art Unit 3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on August 7, 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3-11 and 13-17 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3-11 and 13-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 7, 2006 has been entered.

Status of Claims

This communication is in response to amendment filed on January 13, 2006. Claims 1 and 11 have been amended and 2 and 12 have been canceled. Claims 1, 3-11 and 13-17 remain pending.

Response to Arguments

Applicant's arguments filed August 7, 2006 have been fully considered but they are not persuasive.

Applicant has currently amended the claims to recite: "said inquiry information being used to indicate whether the digital data was encoded to recorded in a manner consistent with the digital signal processing apparatus (or method)..." Applicant contends that the above noted amendment provides the limitation of determining whether the data was "recorded by the same apparatus or another legally recognized apparatus (response p. 9)." In other words, applicant contends that the comparison of the compression formats utilized to record such data can accomplish the purported objective. Id. The examiner respectfully disagrees.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., determination of whether the data was recorded by the same apparatus) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Determination of two compatible "encoded or recorded" formats by themselves cannot determine the origin of the recording apparatus, but merely compatibility with the apparatus. The argument forwarded by applicant is therefore not reflected in the language of the claims.

Furthermore, the encoding and recording of formats presented by applicant merely determine compatibility of one application with the originating program or one that is compatible to read such data. "Data in a file is stored in a format that is established by whatever application created the file (i.e., organized the data) and typically needs to be read by the same or similar program that can interpret the format and present the data to the user on the computer screen (<http://www.webopedia.com/TERM/f/format.html>)."¹ As such, applicant's contention that such limitation determines whether data was recorded by the "same apparatus or another legally recognized apparatus" is without merit.

Moreover, Ginter discloses, "certain control methods that have been expressly certified as securely interoperable and compatible with said application may be independently submitted by a participant as part of such a contribution. In the most general example, a generally certified load module (certified for a given VDE arrangement and/or content class) may be used with many or any VDE application that operates in nodes of said arrangement. These parties, to the extent they are allowed, can independently and securely add, delete, and/or otherwise modify the

specification of load modules and methods, as well as add, delete or otherwise modify related information [0161].

The arguments below are incorporated from the previous response for reference in light of the request for continued examination:

Applicant has amended the claims to overcome the rejection based on Ginter. Applicant contends that the claimed subject matter is distinguishable from the cited reference since “the information or digital data of the claims is already stored in the storage medium and the apparatus makes inquiries as to whether the stored information has been legally purchased (response p. 11).” Applicant concedes that in “Ginter et al., the paragraph 0222 discloses the transmitting of inquiry information to an information center, the inquiry information being generated in association with digital data that has been recorded on a storage medium.” Id. Applicant then contends that “this is not the same as inquiring whether the information has been legally purchased or not, wherein the information is already in the storage medium.” Id. Accordingly, the applicant concludes that in light of the amendments to the claims, the distinguishing feature is “offering an additional service to a user by using encoded digital data that is already stored in the storage medium.” Id.

The examiner respectfully disagrees. Ginter discloses many variations to protecting, tracking, and distributing digital information via a VDE. Applicant’s feature is anticipated by the Ginter reference and is not novel in light of the art. For instance, in paragraph 0221 Ginter provides that such “information would be useful in tracking who may have "broken" the security of a VDE installation and was illegally making certain electronic content available to others. Fingerprinting may provide additional, available information such as time and/or date of the

release (for example extraction) of said content information. Locations for inserting fingerprints may be specified by VDE installation and/or content container control information. This information may specify that certain areas and/or precise locations within properties should be used for fingerprinting, such as one or more certain fields of information or information types. Fingerprinting information may be incorporated into a property by modifying in a normally undetectable way color frequency and/or the brightness of certain image pixels, by slightly modifying certain audio signals as to frequency, by modifying font character formation, etc. Fingerprint information, itself, should be encrypted so as to make it particularly difficult for tampered fingerprints to be interpreted as valid. Variations in fingerprint locations for different copies of the same property; "false" fingerprint information; and multiple copies of fingerprint information within a specific property or other content which copies employ different fingerprinting techniques such as information distribution patterns, frequency and/or brightness manipulation, and encryption related techniques, are features of the present invention for increasing the difficulty of an unauthorized individual identifying fingerprint locations and erasing and/or modifying fingerprint information." As such, applicant's amendments fail to distinguish the claimed subject matter from the cited reference.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3-11 and 13-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al. (hereinafter Ginter), US 2004/0133793 A1.

As per the following claims, Ginter discloses:

1. A digital signal processing apparatus comprising:

-transmitting means for transmitting inquiry information to an information center over a communication line, said inquiry information being generated in association with encoded digital data which have been recorded on a storage medium, said inquiry information being used to indicate whether the digital data was encoded to recorded in a manner consistent with the digital signal processing apparatus [0008, 0161, 0215-226, 0478, 0621, 0663];

-receiving means for receiving a result of an inquiry conducted by said information center based on said inquiry information [0226-0240];

-discriminating means for judging, based on said result of said inquiry, whether said encoded digital data recorded on said storage medium are legally purchased data [1118, 1126, 1540, 1858, 1971-1975]; and

-controlling means which, if said discriminating means judges said encoded digital data to be legally purchased data, then executes a process to offer an additional service to said customer, wherein said additional service is offered to said customer by said controlling means by transmitting said encoded digital data from said storage medium to another storage medium [0057-0093, 0192, 0208, 0215-0222].

2. Canceled.

3. A digital signal processing apparatus according to claim 1, wherein said additional service is offered to said customer by said controlling means converting said encoded digital data recorded on said storage medium with an algorithm of a predetermined version, into digital data having undergone encoding with an algorithm of a more advanced version, before replacing the unconverted digital data with the converted digital data on said storage medium [0965, 1478, 1511, 2017, 2280].

4. A digital signal processing apparatus according to claim 1, wherein said additional service is offered to said customer by said controlling means restoring said digital data having undergone said predetermined low bit rate coding process onto said storage medium [0186-0191, 2064].

5. A digital signal processing apparatus according to claim 1, wherein said additional service is offered to said customer by said controlling means converting said encoded digital data recorded on said storage medium into encoded digital data a different bit rate, before replacing the unconverted digital data with the converted digital data on said storage medium [2279-2321].

6. A digital signal processing apparatus according to claim 1, wherein said additional service offered to said customer comprises furnishing said customer, free of charge, with a product related to a producing party who produced said digital data purchased legally by said customer from said information center [0107-0141].

7. A digital signal processing apparatus according to claim 1, further comprising inputting means

for inputting identification information for identifying said encoded digital data which are subject to said inquiry; wherein said identification information input through said inputting means is transmitted to said information center over said communication line [0193-0229].

8. A digital signal processing apparatus according to claim 7, wherein said information center comprises: receiving means for receiving said inquiry information and said identification information for identifying said encoded digital data which are subject to said inquiry transmitted from said encoded digital signal processing apparatus; retrieving means for retrieving said digital data subject to said inquiry from said information center in association with said identification information for identifying said encoded digital data; reference inquiry information generating means for generating reference inquiry information in association with said encoded digital data retrieved by said retrieving means; comparing means for comparing said reference inquiry information generated by said reference inquiry information generating means with said inquiry information received by said receiving means; inquiry result generating means for generating an inquiry result based on a result of the comparison by said comparing means; and transmitting means for transmitting said inquiry result generated by said inquiry result generating means [0509, 0722].

9. A digital signal processing apparatus according to claim 8, wherein said reference inquiry information generating means subjects part of said encoded digital data retrieved by said retrieving means to an encoding process executed by a software encoder, the coded data part being compared with said inquiry information by said comparing means [1350-1814].

10. A digital signal processing apparatus according to claim 1, further comprising charging means for processing charges; wherein, if said discriminating means judges that said encoded digital data recorded on said storage medium are legally purchased data, then said charging means either charges nothing or a reduced amount to said customer for said additional service offered to said customer [0222-0272].

Claims 11 and 13-17 are directed to a method of the above-recited apparatus and are similarly rejected.

Although the Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action, the specified citations are merely representative of the teachings in the art as applied to the specific limitations within the individual claim. Since other passages and figures may apply to the claimed invention as well, it is respectfully requested that the applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US 2002/0052849 A1 to McCutchen et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley B. Bayat whose telephone number is 571-272-6704. The examiner can normally be reached on Tuesday - Friday 8 a.m.-6:30 p.m. and by email: bradley.bayat@uspto.gov. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached regarding urgent matters at (571) 272-6779.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 571-272-6584.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
P.O. Box 1450
Alexandria, VA 2231-1450

Or faxed to:

(571) 273-8300 - Official communications; including After Final responses.

(571) 273-6704 - Informal/Draft communications to the examiner.



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